

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TODD L. LYDIC and TAMO BIANCHI

Appeal No. 2002-0694
Application No. 08/712,369

ON BRIEF



Before COHEN, NASE, and BAHR, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 19, 29 through 31, and 33. These claims constitute all of the claims remaining in the application.

Appellants' invention pertains to a center sill for a railroad car, a beam for use with the underframe of a vehicle, and to a center sill for use with the underframe of a railroad car. A basic understanding of the invention can be derived from

a reading of exemplary claims 1, 14, and 19, respective copies of which appear in the "APPENDIX A" of the main brief (Paper No. 20).

As evidence of anticipation and obviousness, the examiner has applied the documents listed below:

Slick	1,279,600	Sep. 24, 1918
Heap	4,254,714	Mar. 10, 1981
Meyer	5,157,883	Oct. 27, 1992

The following rejections are before us for review.

Claims 1, 3 through 5, 10 through 12, 14 through 17, 29, and 31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Slick.

Claims 1, 3 through 5, 14 through 17, and 29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Heap.

Claims 2, 13, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Slick.

Claims 6 through 9, 18, 19, and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Heap in view of Meyer.

The full text of the examiner's rejections and response to the argument presented by appellants appears in the answer (Paper No. 21), while the complete statement of appellants' argument can be found in the main and reply briefs (Paper Nos. 20 and 23).

OPINION

In reaching our conclusion on the anticipation and obviousness issues raised in this appeal, this panel of the board has carefully considered appellants' specification and claims, the applied teachings,¹ and the respective viewpoints of

¹ In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the Board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejections

We do not sustain the rejection of claims 1, 3 through 5, 10 through 12, 14 through 17, 29, and 31 under 35 U.S.C. § 102(b) as being anticipated by Slick.

Independent claims 1, 14, and 29 address at least the following features. Claim 1 requires a cold formed center sill being formed from a single flat member. Claim 14 specifies a beam comprising a one piece cold formed steel member. Claim 29 sets forth a center sill comprising a steel member having an elongated body with portions interconnected by cold hardened curved portions.

Like the examiner, we readily appreciate the relevance of the Slick patent to the now claimed subject matter. More specifically, this panel of the Board perceives that one versed in the center sill art would comprehend the center sill 3 of Slick (Fig. 3) as being configured of one piece pressed or rolled

steel. However, the Slick reference fails to disclose cold forming or cold hardening, which we understand to be processes which do render a resulting workpiece with distinguishable characteristics that are discernible in the formed workpiece.² Since the Slick reference, in and of itself, does not expressly teach or inherently require cold forming or hardening in fabricating the disclosed rolled steel center sill, the evidence before us does not support an anticipation rejection of appellants' claims. It is for this reason that the rejection under 35 U.S.C. § 102(b) founded upon the Slick patent cannot be sustained.

We do not sustain the rejection of claims 1, 3 through 5, 14 through 17, and 29 under 35 U.S.C. § 102(b) as being anticipated by Heap.

² Appellants have attached a copy of an earlier submitted Chapter 19 ("PLASTIC DEFORMATION OF STEEL") from a text ("The Making, Shaping and Treating of Steel") which is indicated to be the authoritative reference work in the steel industry (main brief, page 6). The Chapter 19 documentation informs us of the knowledge and level of skill in the art, at the time of appellants' invention, as to hot and cold working processes pertaining to steel.

Simply stated, we find that the Heap patent is silent as to the fabrication of the continuous center sill 20 (Fig. 3). Thus, the teaching of Heap, lacking any disclosure of cold forming or hardening, clearly cannot support the rejection of appellants' claims as being anticipated thereby. For the foregoing reason, we do not sustain the anticipation rejection based upon the Heap patent.

The obviousness rejections

We do not sustain the rejection of claims 2, 13, and 30 under 35 U.S.C. § 103(a) as being unpatentable over Slick.

Dependent claims 2, 13, and 30 address specific yield strength, thickness ranges, and strength and thickness, respectively, of a center sill that is cold formed or cold hardened. We earlier addressed the circumstance, however, that the Slick reference, in and of itself, does not expressly teach or inherently require cold forming or hardening in fabricating the disclosed rolled steel center sill. Since the sole reference relied upon lacks a teaching of cold forming or hardening a

center sill, parameters for a fabricated center sill resulting from such processes, as now claimed, would not have been obvious.

We do not sustain the rejection of claims 6 through 9, 18, 19, and 33 under 35 U.S.C. § 103(a) as being unpatentable over Heap in view of Meyer.

From our perspective, the applied evidence, collectively considered, would not have been suggestive of the rejected dependent claims at issue. First, the Heap document lacks a disclosure of cold forming or hardening of a center sill or beam and any suggestion therefor, as now claimed. Second, the Meyer document does not overcome the deficiency of the Heap reference. We do not share the examiner's view (answer, page 6) that appellants' center sill or beam for use with the underside of a vehicle is essentially in the same field as Meyer's structural frame (metal wall stud).³

³ The test of whether a reference is from a nonanalogous art is first, whether it is within the field of the inventor's endeavor, and second, if it is not, whether it is reasonably pertinent to the particular problem with which the inventor was involved. See In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). A reference is reasonably pertinent if, even though it may be in a different field of endeavor, it is one which

(continued...)

REMAND TO THE EXAMINER

We remand this application to the examiner to consider a rejection of appellants' claims based upon the combined teachings of Slick and the Chapter 19 documentation of record. The examiner should determine whether it would have been obvious to one having ordinary skill in the art, at the time appellants' invention was made, to select cold rolling from among the known hot rolling and cold rolling method alternatives (Chapter 19 documentation) when fabricating the rolled steel center sill of Slick to achieve the desired, known, and expected advantages of the cold rolling method that would be reflected in the characteristics of the resulting center sill. As to the chosen particular parameters and configuration for a cold worked center sill (dependent claims), the examiner should determine whether these features would have been obvious to one having ordinary skill in the center sill and beam art, relying upon relevant and

³(...continued)
because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. **In re Clay**, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992).

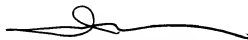
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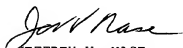
reasonably pertinent evidence and/or a sound technical line of reasoning.

In summary, this panel of the board has not sustained any of the rejections on appeal. Further, we have remanded the application to the examiner to consider the matter discussed above.

The decision of the examiner is reversed.

REVERSED AND REMANDED


IRWIN CHARLES COHEN)
Administrative Patent Judge)


JEFFREY V. NASE)
Administrative Patent Judge)

) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)


JENNIFER D. BAHR)
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